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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Takuro Ikeda

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EXAMINER

SMITH, TRACI L

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,181

Applicant(s)

IKEDA ET AL.

Examiner

Traci L. Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to papers filed on November 22, 2005.

Claims 1-11 have been amended.

Claims 12-14 have been cancelled.

Claims 1-11 are pending.

Claims 1-11 are rejected.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. As to Claim 1-11 include language such as "outputting dialogue content" where is the content being output to? Further more examiner is unable identify the different between transmitting the dialogue content and outputting the dialogue content.

4. Regarding claims 2-3, 5, the word "means" is preceded by the word(s) "scenario storage means" "customer information storage means" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. In both cases, how does a storage means assign something, a storage means is for storing. This could simply be overcome by dropping the language preceding the means. However, since no function is specified by the word(s) preceding "means," it is

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impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 and 9-11 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,766,319 Might; Method and Apparatus for Gathering and Evaluating Information. Hereinafter, referred to as Might. The reference cited in this rejection is applied to the above mentioned claims as they are best understood by the examiner.

7. As to claims 1-2, 5-6 and 9-11 Might teaches

- a. Inputs with respect to specific topics(ie categories, products) that were previously stored(C. 2 l. 59-63).
- b. Picking which topic the individual wishes to participate in.(C. 3 l. 23-26).
- c. Communication between survey supplier and individual(C. 1 l. 20-23).
- d. Storing information from communication (C. 2 item 8).

- e. Store reports requested by user in a specific location(C. 20 I. 43-45 and 59-65)
 - f. Reporting communication information(C. 3 I. 16-21).
 - g. Databases for storing several different items and aspects of the information gathering process. (C. 9 I. 50-55; C. 10 I. 49-52; C. 13 I. 18-30)
8. Although, does not explicitly recited the information being "merchandise information" as recited in claims 5-6 it is inherent a if an individual is a customer they will be reporting on the "merchandise" was purchased or used from the provider. Furthermore, the fact that the information is "merchandise information" these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information input. The claims fail to recite a manipulation of the information that is collected there, they are merely input and the transmitted in the same form in which they were input. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).
9. As to claim 3 Might teaches storing customer information that identifies the customer via information input by the customer(C. 3 I. 66-67 & C. 4 I. 1-3)
10. Might further teaches using statistical information rather than raw information therefore removing the users identity from the survey input information.

11. As to claims 4 Might teaches storing the communication information(C. 1 I. 20-23).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,766,319 Might as applied to claim 1-6 and 9-11 above, and further in view of US Patent Publication 2001/0032115 A1 Goldstein; System and Methods for internet commerce and communication based on customer interaction and preferences.

Hereinafter referred to as Goldstein. The references cited in this rejection are applied to the above mentioned claims as they are best understood by the examiner.

15. As to claims 7-8 Might teaches a system and method for users inputting information regarding products/services or merchandisers. Might fails to teach a means for billing/compensation and notification of billing/compensation information. Goldstein

teaches purchasing information for survey information that a user requests from a survey they did not develop. Goldstein further teaches a portion of the proceeds going to the creator the survey as a means for compensating the creator for their work. It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Goldstein with Might so as to have incentives to both using others surveys and creating surveys that other will be able to use the data from.

Response to Arguments

16. Applicant's arguments filed November 22, 2005 have been fully considered but they are not persuasive.

17. As to applicants arguments regarding Might not teaching dialogue scenarios transmitting to a plurality of locations the examiner notes applicant is only claiming transmitting to "a" destination address; therefore qualifying it in the singular.

Furthermore, applicant argues Might only using a single database server. Applicant again is not claiming multiple servers. However, the examiner notes Might teaches and discloses five separate databases as well as the system being used on any combination of networks.). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. As to applicants arguments regarding a request of proof of "inherentancy" according to MPEP 2144. The examiner notes applicants arguments are addressing

rebuttals guidelines with respect to an "Official Notice" used in a 35 USC103 obviousness rejection not against a 35 USC102 anticipation rejection. However, the examiner will clarify how Might anticipates applicants claim with regard to 5 and 6. Applicant is claiming a device with means that transmits information, accepts information and storing information. The device of Might has the equivalent means structure for performing in the manner as applicants device. The that the specific information being processed by the device is not identical in terminology to applicants information is non-functional. The Might's device will still accept, transmit and store the information as applicants device. The examiner further notes the information merely identifies the product the user is surveying one, Might teaches that customers do product surveys by identifying a specific topic/category. Selecting a product(specific topic) is interpreted as merchandise identification. Therefore, Might does anticipate the limitations of applicants claims.

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner points applicant to C. 1 I. 53-58 in which Might identifies deficiency in the conventional method as those surveyed leaving surveys unanswered and losing interest. Goldstein

identifies rewards as a way to entice and give incentive for users to participate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Goldstein with Might in order to "entice" those that have lost interest in the surveys to now complete them.

20. As to applicants comments regarding a lack of rejection with respect to claim 8.

The examiner notes claim 8 is identified as being rejected under 35 USC 103 in paragraph 27. Examiner asserts that upon reviewing the reasons for rejection in paragraph 28 it is apparent it was a typographical error, which has been corrected, in not noting claim 8 not a failing to provide an analysis. When reading reasons in paragraph 28 examiner believes applicant understands claim 8 is being addressed as the reasons both state billing and compensation limitations. Claim 7 is solely addressed to billing limitations and claim 8 solely addressing compensation limitations. Therefore, examiner believes an inadvertent typographical error does not render an improper reasoning or analysis.

21. As to applicants arguments regarding rejections under 35 USC 112, some rejections were removed in view of applicants amendments, however, some rejections stand and are restated above as not being properly amended to overcome rejection.

22. As to applicants arguments regarding rejections under 35 USC 101 and technological arts in view of Ex parte Lundgren, examiner withdraws 101 rejection.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

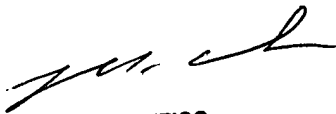
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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